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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,220	05/14/2001	Mirsad Hadzikadic	46872.253156	9820

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EXAMINER

ROBINSON, GRETA LEE

ART UNIT	PAPER NUMBER
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2177

DATE MAILED: 08/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/855,220

Applicant(s)

HADZIKADIC ET AL.

Examiner

Greta L. Robinson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) ✓
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-24 are pending in this application. Claims 8-24 have been cancelled; and claim 1 has been amended.

Drawings

2. The drawings were received on June 1, 2004. These drawings are acceptable.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 1-7, Applicant does not appear to adequately define the claimed limitation an instance. The examiner notes page 4 lines 9-10 of the disclosure makes reference to **classifying data** (otherwise known as **instance**) using a computer system; whereas on page 6 lines 12-13, the disclosure makes reference to *an instance* as being *data*. It is unclear from the disclosure as to what Applicant is referring to with

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regards to the limitation “classifying an instance” [note claim 1 line 1] and an instance [claim 1 line 2]. Also, the limitation “receiving an instance to be classified, the instance to be classified comprising at least one attribute and a corresponding relevance value” [claim 1 lines 3-4] does not appear to be described properly. Note page 22 lines 14-16 of the disclosure states an “overall classification mechanism comprises a computational server 135 first **receiving an instance to be classified (the instance comprising at least one attribute value and corresponding relevance value)**”; while page 22 lines 24-26 describes an “**instance comprises a data point**, which represents a specific type of object that possesses certain characteristics or attributes”. The description of the term instance does not appear to be described properly and it is unclear as to how the two definitions connect.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the following limitation is vague: “classifying an instance” [note claim 1 line 1] and an instance [claim 1 line 2]. Claims 2-7 are rejected based on dependency.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claimed invention "classifying instance data" is not supported by either a computer or a machine or manufacture for performing the method steps, that is the claim does not define a useful machine or manufacture by identifying the physical structure of the machine or manufacture in terms of its hardware or hardware and software combination to assert utility and therefore is non-statutory subject matter. The method steps cannot be achieved without a computer or a machine or manufacture for performing a process.

Response to Arguments

9. Applicant's arguments filed June 1, 2004 have been fully considered but they are not persuasive.

In the response Applicant argued the term instance is adequately defined in the Specification. For example, the definition of the claim term "instance" begins on page 22, "**An instance comprises a data point**, which represents a specific type of object

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that poses certain characteristics or attributes". Applicant states that the amendment deleting the term "data" overcomes the rejection.

With regards to the rejection cited under 35 USC 112 second paragraph, **Applicant states that the limitation in the preamble of the claim "classifying instance data" is not a limitation.** Applicant states that the term "classifying instance data" is not necessary to give life, meaning and vitality to the claim. And in response to the rejection cited under 35 USC 101 Applicant simply argues that the claimed process produces a useful tangible and concrete result citing case law.

In response to the arguments the Examiner respectfully disagrees with Applicant. The disclosure appears to give two separate definitions for the term instance and it is not clear how the definitions connect. Note paragraph four above which reads as follows:

The examiner notes page 4 lines 9-10 of the disclosure makes reference to **classifying data** (otherwise known as **instance**) using a computer system; whereas on page 6 lines 12-13, the disclosure makes reference to *an instance* as being *data*. It is unclear from the disclosure as to what Applicant is referring to with regards to the limitation "classifying an instance" [note claim 1 line 1] and an instance [claim 1 line 2]. Also, the limitation "receiving an instance to be classified, the instance to be classified comprising at least one attribute and a corresponding relevance value" [claim 1 lines 3-4] does not appear to be described properly. Note page 22 lines 14-16 of the disclosure states an "overall classification mechanism comprises a computational server 135 first **receiving**

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an instance to be classified (the instance comprising at least one attribute value and corresponding relevance value)”; while page 22 lines 24-26 describes an **“instance comprises a data point**, which represents a specific type of object that possesses certain characteristics or attributes”. The description of the term instance does not appear to be described properly and it is unclear as to how the two definitions connect.

Applicant’s argument that the term “classifying instance data” (as cited in original claim 1) in the preamble of claim 1 is not a limitation **is not correct**. Applicant has not properly responded to this rejection, simply stating that the preamble does not give life, meaning and vitality to the claim does not clarify claim limitation. Also Applicant should note a typographical error on page 8 of the response, under the section heading Conclusion; Applicant states that “claims 46-72 are allowable” this is not correct because only claims 1-7 are pending.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kavanagh et al. US Patent 5,838,965 teaches an object-oriented database management system that provides a hierarchical tree structure showing a classification structure and a class or instance may be selected. An algorithm is presented for adding an instance to the tree structure.

Mital et al. US Patent 6,003,040 teaches a hierarchical structure of topic and subtopic nodes with parent/child relationships that classifies object instances.

Gustman US Patent 5,832,495 teaches an unclassified element instance can be classified by selecting an element instance and dragging its display from unclassified display area to classified display area. This allows the element instance to be inserted into the element hierarchy.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greta L. Robinson whose telephone number is (703) 308-7565. The examiner can normally be reached on Mon.-Fri. 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (703) 305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



GRETA ROBINSON
PRIMARY EXAMINER

Greta Robinson
Primary Examiner
August 24, 2004